

## **REMARKS:**

Claims 1-37 are currently pending in the application.

Claims 34-37 stand objected to as allegedly being substantial duplicate. Claims 1-37 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory matter. Claims 1-37 stand rejected under 35 U.S.C. § 112 as allegedly being indefinite. Claims 1-6, 12-17, 23-28, and 34-37 stand rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 6,055,515 to Consentino *et al.* ("*Consentino*"). Claims 7-11, 18-22, and 29-33 stand rejected under 35 U.S.C. § 103(a) over *Consentino* in view of U.S. Patent No. 6,789,091 B2 to Victor Gogolak ("*Gogolak*").

Although the Applicant believes claims 1-37 are directed to patentable subject matter without amendment, the Applicant has amended claims 1-9, 12-20, 23-31, and 34-37 to more particularly point out and distinctly claim the Applicant's invention. By making these amendments, the Applicant makes no admission concerning the merits of the Examiner's rejection, and respectfully reserves the right to address any statement or averment of the Examiner not specifically addressed in this response. Particularly, the Applicant expressly reserves the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

## **CLAIM OBJECTIONS:**

Claims 34-37 stand objected to as allegedly being substantial duplicate.

The Examiner specifically states that "Claims 34 and 35, are objected to under 37 C.F.R. § 1.75 as [allegedly] being a substantial duplicate of claim 1." (28 March 2006 Office Action, Page 2). The Applicant respectfully disagrees. The Examiner further specifically states that "Claims 36 and 37, are objected to under 37 C.F.R. § 1.75 as [allegedly] being a substantial duplicate of claims 12 and 23 respectively." (28 March 2006 Office Action, Page 2). The Applicant respectfully disagrees.

The Applicant does not understand why the Examiner believes claims 34-36 are thought to be a substantial duplicate and respectfully requests further explanation from the Examiner. The Examiner may call the undersigned at (817) 447-9955 if the Examiner believes that it would be easier to discuss the source of confusion over the phone. The Applicant respectfully directs the Examiner's attention to the pertinent part of the Examiner's cited MPEP cite:

Inasmuch as a patent is supposed to be limited to only one invention or, at most, several closely related indivisible inventions, limiting an application to a single claim, or a single claim to each of the related inventions might appear to be logical as well as convenient. However, ***court decisions have confirmed applicant's right to restate*** (i.e., by plural claiming) ***the invention in a reasonable number of ways. Indeed, a mere difference in scope between claims has been held to be enough.*** (MPEP § 706.03(k) (Emphasis Added).

The Applicant respectfully traverses the Examiner's Objection to claims 34-36 as being a substantial duplicate of other independent claims in the subject Application. In addition, the Applicant respectfully submits that claims 34-36 are considered to be in full compliance with the requirements of 37 C.F.R. § 1.75. Thus, the Applicant respectfully requests that the objection of claims 34-36 under 37 C.F.R. § 1.75 be reconsidered and that claims 34-36 be allowed.

#### **REJECTION UNDER 35 U.S.C. § 101:**

Claims 1-37 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory matter.

The Examiner specifically states that "an association of target data with a product classification schema [...] seems to apply certain abstract accessing". (28 March 2006 Office Action, Page 3). The Applicant respectfully disagrees. Nonetheless, the Applicant has amended independent claims 1, 12, 23, and 34-37 in an effort to expedite prosecution of this Application and to more particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. By making these amendments, the

Applicant does not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 101, as set forth in the Office Action.

The Applicant respectfully submits that claims 1-37 are considered to be in full compliance with the requirements of 35 U.S.C. § 101. Thus, the Applicant respectfully requests that the rejection of claims 1-37 under 35 U.S.C. § 101 be reconsidered and that claims 1-37 be allowed.

#### **REJECTION UNDER 35 U.S.C. § 112:**

Claims 1-37 stand rejected under 35 U.S.C. § 112 as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner specifically states that "the use of the phrases "may be" and "should be" renders these claims indefinite, since these phrases lead to a question of whether the claimed operation really occurred." (28 March 2006 Office Action, Page 4). The Applicant respectfully disagrees. Nonetheless, the Applicant has amended claims 1-9, 12-20, 23-31, and 34-37 in an effort to expedite prosecution of this Application and to more particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. By making these amendments, the Applicant does not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 112, as set forth in the Office Action.

The Applicant respectfully submits that claims 1-37 are considered to be in full compliance with the requirements of 35 U.S.C. § 112. Thus, the Applicant respectfully requests that the rejection of claims 1-37 under 35 U.S.C. § 112 be reconsidered and that claims 1-37 be allowed.

## **REJECTION UNDER 35 U.S.C. § 102(b):**

Claims 1-6, 12-17, 23-28, and 34-37 stand rejected under 35 U.S.C. § 102(b) over *Consentino*.

Although the Applicant believes claims 1-37 are directed to patentable subject matter without amendment, the Applicant has amended claims 1-9, 12-20, 23-31, and 34-37 to more particularly point out and distinctly claim the Applicant's invention. By making these amendments, the Applicant does not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 102(b), as set forth in the Office Action.

The Applicant respectfully submit that *Consentino* fails to disclose each and every limitation recited by claims 1-6, 12-17, 23-28, and 34-37. The Applicant further submit that claims 1-6, 12-17, 23-28, and 34-37 patentably distinguish over *Consentino*. Thus, the Applicant respectfully traverses the Examiner's rejection of claims 1-6, 12-17, 23-28, and 34-37 under 35 U.S.C. § 102(b) over *Consentino*.

### ***Consentino* Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Claims**

For example, with respect to amended independent claim 1, this claim recites:

A computer-implemented ***system for categorizing product data in an electronic commerce transaction***, the system comprising ***a data association module operable to:***

***access a first product classification schema***, the first schema comprising a taxonomy comprising a hierarchy of classes for categorizing products, the first schema further comprising ontologies associated with one or more of the classes, each ontology comprising one or more product attributes;

***access target data to be associated with the first schema***, the target data organized according to a second product classification schema;

***determine one or more classes of the first schema with which at least a portion of the target data is associated based on an automatic comparison***, without translating the target data from the second schema to the first schema, between the target data and the product attributes of the ontologies of the first schema or between the

target data and values for one or more of the product attributes of the ontologies of the first schema; and

**associate the at least a portion of the target data with one or more classes of the first schema in response to determining**, based on the automatic comparison, **the one or more classes of the first schema** with which the at least a portion of the target data is associated. (Emphasis Added).

Amended independent claims 12, 23, and 34-37 recite similar limitations. *Consentino* fails to disclose each and every limitation of amended independent claims 1, 12, 23, and 34-37.

The Applicant respectfully submit that *Consentino* has nothing to do with amended independent claim 1 limitations regarding a “computer-implemented **system for categorizing product data in an electronic commerce transaction**” and in particular *Consentino* has nothing to do with amended independent claim 1 limitations regarding “**determine[ing] one or more classes of the first schema with which at least a portion of the target data is associated based on an automatic comparison**, without translating the target data from the second schema to the first schema, between the target data and the product attributes of the ontologies of the first schema or between the target data and values for one or more of the product attributes of the ontologies of the first schema”. In particular, the Examiner equates “**determine[ing] one or more classes of the first schema with which at least a portion of the target data is associated based on an automatic comparison**” recited in amended independent claim 1 with a user that must “**determine the product description by clicking on the node**” disclosed in *Consentino*. (28 March 2006 Office Action, Pages 4-6). (Emphasis Added). However, “**clicking on the node**” disclosed in *Consentino* merely allows a user to determine the product description and to look at its parameters, and **does not include, involve, or even relate to** “**determine[ing] one or more classes of the first schema with which at least a portion of the target data is associated based on an automatic comparison**”, as recited in amended independent claim 1. (Column 6, Lines 42-48). In contrast, the “**determine[ing] one or more classes of the first schema with which at least a portion of the target data is associated based on an automatic comparison**” recited in amended independent claim 1 provides for an “**automatic comparison**”. Thus, the

Applicant respectfully submits that the equations forming the foundation of the Examiner's comparison between *Consentino* and amended independent claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent claim 1 from *Consentino*.

The Applicant respectfully submits that the allegation in the present Office Action that *Consentino* discloses all of the claimed features is respectfully traversed. Further, it is noted that the Office Action provides no concise explanation as to how *Consentino* is considered to anticipate all of the limitations claims 1-6, 12-17, 23-28, and 34-37. ***A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if each and every element of a claimed invention is identically shown in that single reference.*** MPEP § 2131. (Emphasis Added). With respect to the subject Application, the Examiner has not adequately supported the rejection under 35 U.S.C. § 102, because the Examiner has not shown how each and every element of the Applicant claimed invention is identically shown in *Consentino*. For example, the Examiner asserts that the ***"determine[ing] one or more classes of the first schema with which at least a portion of the target data is associated based on an automatic comparison"***, in amended independent claim 1 is somehow equivalent with ***"clicking on the node"*** disclosed in *Consentino*. (28 March 2006 Office Action, Pages 4-6). ***The Applicant respectfully disagrees and further respectfully request clarification as to how the Examiner arrives at this conclusion.*** The Applicant respectfully points out that "it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." Ex parte Levy, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990). The Applicant respectfully submit that ***the Office Action has failed to establish a prima facie case of anticipation in claims 1-6, 12-17, 23-28, and 34-37 under 35 U.S.C. § 102 with respect to Consentino because Consentino fails to identically disclose each and every element of the Applicant's claimed invention, arranged as they are in Applicant's claims.***

**The Applicant's Claims are Patentable over *Consentino***

With respect to amended independent claims 12, 23, and 34-37 these claims includes limitations similar to those discussed above in connection with amended independent claim 1. Thus, amended independent claims 12, 23, and 34-37 are considered patentably distinguishable over *Consentino* for at least the reasons discussed above in connection with amended independent claim 1.

Furthermore, with respect to dependent claims 2-6, 13-17, and 24-28: claims 2-6 depend from amended independent claim 1; claims 13-17 depend from amended independent claim 12; and claims 24-28 depend from amended independent claim 23. Thus, dependent claims 2-6, 13-17, and 24-28 are considered patentably distinguishable over *Consentino* and are also considered to be in condition for allowance for at least the reason of depending from an allowable claim.

Thus, for at least the reasons set forth herein, the Applicant respectfully submits that independent claims 1, 12, 23, and 34-37 and dependent claims 2-6, 13-17, and 24-28 are not anticipated by *Consentino*. The Applicant further respectfully submits that independent claims 1, 12, 23, and 34-37 and dependent claims 2-6, 13-17, and 24-28 are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of claims 1-6, 12-17, 23-28, and 34-37 under 35 U.S.C. § 102(b) be reconsidered and that claims 1-6, 12-17, 23-28, and 34-37 be allowed.

#### **THE LEGAL STANDARD FOR ANTICIPATION REJECTIONS UNDER 35 U.S.C. § 102:**

The following sets forth the legal standards for "anticipation."

The events that can lead to anticipation can be divided into the following seven categories, all defined by statute:

1. **Prior Knowledge:** The invention was publicly known in the United States before the patentee invented it.

2. Prior Use: The invention was publicly used in the United States either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.

3. Prior Publication: The invention was described in a printed publication anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.

4. Prior Patent: The invention was patented in another patent anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his application.

5. On Sale: The invention was on sale in the United States more than one year before the patentee filed his application.

6. Prior Invention: The invention was invented by another person in the United States before the patentee invented it, and that other person did not abandon, suppress or conceal the invention.

7. Prior U.S. Patent: The invention was described in a patent granted on a patent application filed in the United States before the patentee made the invention.

Each of those seven events has its own particular requirements, but they all have the following requirements in common:

1. Anticipation must be shown by clear and convincing evidence.
2. If one prior art reference completely embodies the same process or product as any claim, the product or process of that claim is anticipated by the prior art, and that claim is invalid. To decide whether anticipation exists, one must consider each of the elements recited in the claim and determine whether all of them are found in the particular item alleged to be anticipating prior art.
3. There is no anticipation unless every one of those elements is found in a *single* prior publication, prior public use, prior invention, prior patent, prior knowledge or



prior sale. One may not combine two or more items of prior art to make out an anticipation. One should, however, take into consideration, not only what is expressly disclosed or embodied in the particular item of prior art, but also what inherently occurred in its practice.

4. There cannot be an accidental or unrecognized anticipation. A prior duplication of the claimed invention that was accidental, or unrecognized, unappreciated, and incidental to some other purpose is not an invalidating anticipation.

Those four requirements must be kept in mind and applied to each kind of anticipation in issue. The following additional requirements apply to some categories of anticipation.

1. Prior Knowledge: An invention is anticipated if it was known by others in the United States before it was invented by the patentee. "Known," in this context, means known to the public. Private knowledge, secret knowledge or knowledge confined to a small, limited group is not necessarily an invalidating anticipation. Things that were known to the public only outside the United States are not invalidating anticipation.

2. Prior Use: An invention is anticipated if it was used by others before it was invented by the patentee, or more than one year before the patentee filed his patent application. "Use," in this context, means a public use.

3. Prior Publication: A patent is invalid if the invention defined by the Claims was described in a printed publication before it was invented by the patentee or more than one year prior to the filing date of his application. For a publication to constitute an anticipation of an invention, it must be capable, when taken in conjunction with the knowledge of people of ordinary skill in the art, of placing the invention in the possession of the reader. The disclosure must be enabling and meaningful. In determining whether the disclosure is complete, enabling, and meaningful, one should take into account what would have been within the knowledge of a person of ordinary skill in the art at the time, and one may consider other publications that shed light on the knowledge such a person would have had.

4. Prior Patent: If the invention defined by the claims was patented in the United States or a foreign country, either before it was invented by the inventor or more than one year before the inventor filed his patent application, then the invention was anticipated. The effective date for this type of anticipation is the date on which two things co-existed: (i) the owner of the referenced patent had the right to enforce that patent; and (ii) the reference patent was available to the public. What was "patented" in the reference patent is determined by what is defined by its claims, interpreted in the light of the general description.

5. On Sale: A patent is invalid if the invention claimed in it was on sale in the United States more than one year prior to the application filing date.

6. Prior Invention: If the invention defined by the claims was invented by another person, in the United States, before it was invented by the inventor, and that other person did not abandon, suppress, or conceal the invention, the invention lacks novelty. A prior invention, even if put in physical form and shown to produce the desired result, is not an invalidating anticipation unless some steps were taken to make it public. However, it is not necessary that the inventor had knowledge of that prior invention.

7. Prior U.S. Application: A patent is invalid for lack of novelty if the invention defined by the claims was described in a United States patent issued on a patent application filed by another person before the invention was made by the inventor. The effective date of a prior application for purposes of this issue is the date on which it was filed in the United States. Foreign-filed patent applications do not apply. If the issued United States patent claims the benefit of more than one United States application, its effective date as an anticipation is the filing date of the first United States application that discloses the invention claimed in that referenced patent.

Experimental Use Exception: The law recognizes that it is beneficial to permit the inventor the time and opportunity to develop his invention. As such there is an "experimental use" exception to the "public use" and "on sale" rules. Even though the invention was publicly used or on sale, more than one year prior to the application filing date, that does not invalidate the patent, provided the principal purpose was experimenta-

tion rather than commercial benefit. If the primary purpose was experimental, it does not matter that the public used the invention or that the inventor incidentally derived profit from it.

When a public use or sale is shown, the burden is on the inventor to come forward with evidence to support the experimental use exception. Only experimentation by or under the control of the inventor qualifies for this exception. Experimentation by a third party, for its own purposes, does not qualify for this exception. Once the invention leaves the inventor's control, its use is a public one, even if further experimentation takes place.

The experimentation must relate to the claimed features of the invention. And it must be for the purpose of technological improvement, not commercial exploitation. If any commercial exploitation does occur, it must be merely incidental to the primary purpose of experimentation. A test done primarily for marketing, and only incidentally for technological improvement, is a public use.

**REJECTION UNDER 35 U.S.C. § 103(a):**

Claims 7-11, 18-22, and 29-33 stand rejected under 35 U.S.C. § 103(a) over *Consentino* in view of *Gogolak*.

Although the Applicant believes claims 1-37 are directed to patentable subject matter without amendment, the Applicant has amended claims 1-9, 12-20, 23-31, and 34-37 to more particularly point out and distinctly claim the Applicant's invention. By making this amendment, the Applicant does not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of claims 7-11, 18-22, and 29-33 under 35 U.S.C. § 103(a), as set forth in the Office Action.

The Applicant respectfully submits that *Consentino* or *Gogolak*, either individually or in combination, fails to disclose, teach, or suggest each and every element of claims 7-11, 18-22, and 29-33. Thus, the Applicant respectfully traverses the Examiner's obvious rejection of claims 7-11, 18-22, and 29-33 under 35 U.S.C. § 103(a) over the proposed combination of *Consentino*, and *Gogolak*, either individually or in combination.

**The Proposed *Consentino-Gogolak* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Dependent Claims 7-11, 18-22, and 29-33**

The Applicant respectfully submits that the Office Action acknowledges, and the Applicant agrees, that *Consentino* fails to disclose the limitations in dependent claims 7-11, 18-22, and 29-33. Specifically, the Examiner acknowledges that “*Consentino* does not specifically disclose that the systems determines the association by using vector space analysis and statistical correlation techniques [...] and calculating weight to indexing the read/write processing”. (28 March 2006 Office Action, Pages 6-7). However, the Examiner asserts that the cited portions of *Gogolak* disclose the acknowledged shortcomings in *Consentino*. The Applicants respectfully traverse the Examiner's assertions regarding the subject matter disclosed in *Gogolak*.

The Applicant further respectfully submits that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Consentino* or *Gogolak*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that “it would have been obvious for an ordinary skilled person in the art at the time the invention was made to apply ***the well-known technique*** into *Consentino's* system for determining the associations of these attribute-value pairs with the vector space analysis and statistical correlation techniques as taught by *Gogolak*”. (28 March 2006 Office Action, Page 7). The Applicant respectfully disagree.

The Applicant further respectfully submit that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Consentino* or *Gogolak*, either individually or in combination. The Examiner asserts that the motivation to combine the references as proposed would be because “***the surrounding background noise data will be filtered out based on a use desire.***” (28 March 2006 Office Action, Page 7). (Emphasis Added). The Applicant respectfully disagrees and further respectfully requests clarification as to how the Examiner arrives at this conclusion. For example, what is “***the***

***well-known technique*** [...] for determining the associations of these attribute-value pairs” and how does the Examiner arrive at the conclusion that this is a “***well-known technique***” and to what extent does the Examiner purport that this “***well-known technique***” applies to the subject Application. ***The Applicant respectfully requests the Examiner to point to the portions of Consentino or Gogolak which contain the teaching, suggestion, or motivation to combine these references for the for the Examiner's stated purported advantage.*** In particular, the Applicant respectfully requests the Examiner to point to the portions of *Consentino* or *Gogolak* which expressly state what “***the well-known technique***” is and how it applies to the subject Application. The Applicant further submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.*** *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the ***Examiner has not adequately supported the selection and combination of Consentino or Gogolak to render obvious the Applicant's claimed invention.*** The Examiner's conclusory statements that “***the surrounding background noise data will be filtered out based on a use desire***”, ***does not adequately address the issue of motivation to combine.*** (28 March 2006 Office Action, Page 7). (Emphasis Added). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to “[use] that which the inventor taught against its teacher.” *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, ***the Office Action fails to provide proper motivation for combining the teachings of Consentino or Gogolak***, either individually or in combination.

## **The Applicant's Claims are Patentable over the Proposed *Consentino-Gogolak* Combination**

The Applicant respectfully submits that amended independent claims 1, 12, 23, and 34-37 are considered patentably distinguishable over the proposed combination of *Consentino* and *Gogolak*. This being the case, amended independent claims 1, 12, 23, and 34-37 are considered patentably distinguishable over the proposed combination of *Consentino* and *Gogolak*.

With respect to dependent claims 7-11, 18-22, and 29-33: claims 7-11 depend from amended independent claim 1, claims 18-22 depend from amended independent claim 12, and claims 29-33 depend from amended independent claim 23. As mentioned above, each of amended independent claims 1, 12, 23, and 34-37 are considered patentably distinguishable over *Consentino* and *Gogolak*. Thus, dependent claims 7-11, 18-22, and 29-33 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, the Applicant submits that claims 7-11, 18-22, and 29-33 are not rendered obvious by the proposed combination of *Consentino* and *Gogolak*. The Applicant further submits that claims 7-11, 18-22, and 29-33 are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of claims 7-11, 18-22, and 29-33 under 35 U.S.C. § 103(a) be reconsidered and that claims 7-11, 18-22, and 29-33 be allowed.

### **THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.*** Second, there must be a reasonable expectation of success. Finally, ***the prior art reference*** (or references when combined) ***must teach or suggest all the claim limitations.*** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be

found in the prior art, **and not based on applicant's disclosure**. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, **there must be something in the prior art as a whole to suggest the desirability**, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

**CONCLUSION:**

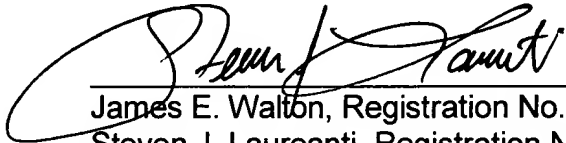
In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although the Applicant believes no fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**.

**Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.**

Respectfully submitted,

6/27/06  
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